



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/884,875

06/18/2001

Lin-feng Chen

UCAL-234

1891

24353

7590

04/20/2005

BOZICEVIC, FIELD & FRANCIS LLP  
1900 UNIVERSITY AVENUE  
SUITE 200  
EAST PALO ALTO, CA 94303

EXAMINER

LEFFERS JR, GERALD G

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,875

Applicant(s)

CHEN ET AL.

Examiner

Gerald G. Leffers Jr., PhD

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 19-31 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 19-24 and 43-48 is/are allowed.
- 6) ☒ Claim(s) 25, 26 and 28-31 is/are rejected.
- 7) ☒ Claim(s) 7-10 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2005 has been entered.

### ***Response to Amendment***

In the response filed on 2/17/2005, several claims were cancelled (claims 32-42) and several new claims were presented (claims 43-48). Claims 1-10, 19-31 and 43-48 are pending in the instant application. New claim 43 finds support in the instant application at pages 30-32 [paragraphs 00116 to 00124] and at page 18 [paragraph 00079] of the originally filed application.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: it lacks an article (e.g. "the" prior to the word "level" in line 7 of the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1636

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This is a new rejection.**

Claim 28 is vague and indefinite in that there is no clear and positive prior antecedent basis for the term "said detectable label" in claim 25, upon which claim 28 is dependent.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-26 & 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganchi et al (Molecular Biology of the Cell, 1992, Vol. 3, pages 1339-1352; see the entire reference). **This is a new rejection.**

Ganchi et al teach a series of experiments that demonstrate that I $\kappa$ B/MAD-3 masks the nuclear localization signal of NF- $\kappa$ B p65 (e.g. Abstract). In one particular experiment, relative concentrations in the cytoplasm and nucleus are determined for NF- $\kappa$ B p65 and NF- $\kappa$ B p50 (Rel A) in both the presence and the absence of I $\kappa$ B/MAD-3 (e.g. Figure 2). In these experiments the NF- $\kappa$ B proteins and the Rel A protein are expressed from expression vectors (Figure 2 legend).

In this instance, I $\kappa$ B/MAD-3 is the test agent used to determine the relative presence of Rel A in the cytoplasm and nucleus. Since the form of Rel A found in the cytoplasm is primarily deacetylated and since I $\kappa$ B/MAD-3 appears to retarget Rel A to the cytoplasm, it follows that

Art Unit: 1636

Ganchi et al are indirectly measuring the level of deacetylated Rel A in the presence of a test agent in a test cell where Rel A is recombinantly expressed. With regard to the limitations of claims 30 & 31 concerning the presence of CBP or p300, one of ordinary skill in the art would necessarily expect those proteins to present, particularly in view of the teachings of the instant specification concerning their role in acetylation/deacetylation of Rel A in eukaryotic cells.

Because the Office does not have the facilities for examining and comparing the applicant's product with the products of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed products and the products of the prior art (e.g. that the products of the prior art do not possess the same material structural and functional characteristics of the claimed product). See *in re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

### ***Conclusion***

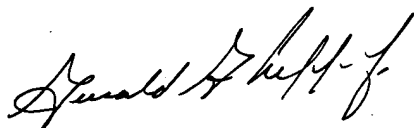
Claims 1-10, 19-31 and 43-48 are pending in the instant application. Claims 25-26, 28-31 are rejected. Claims 1-6, 19-24 and 43-48 are allowed. Claims 7-10 are objected to on the basis of grammar, but are free of the art. Claim 27 is objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form to include the limitations recited in the independent claim upon which they are currently dependent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G. Leffers Jr., PhD whose telephone number is (571) 272-0772. The examiner can normally be reached on 6:30-4:00.

Art Unit: 1636

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit 1636

ggl

**GERRY LEFFERS  
PRIMARY EXAMINER**